

Appl. No. 10/671,388
Amdt. dated August 14, 2008
Reply to Office Action of April 22, 2008
and Notice mailed August 1, 2008

REMARKS/ARGUMENTS

Claims 1-5, 8-9, 11-12 and new claims 23-30 are presented for the Examiner's consideration. Claims 1, and 3-5 have been amended as noted above, and claim 2 cancelled. Support for these amendments is found throughout the filed application and claims, and at for example, at least page 4, line 17 to page 7, line 10, page 24, line 22 to page 28, line 2 and page 30, line 22 to page 31, line 9. New claims 23-30 are added and support is believed to exist in at least the same places as for the amendments. No new matter is believed added by these changes.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

By way of the Office Action mailed April 22, 2008, it notes again that claims 6-7, 10, and 13-22 remain withdrawn, so claim identifiers have been made accordingly for claim 6-7 and 10, and claims 13-22 have been cancelled. It is noted, however, that while the withdrawn claims may be to non-elected species, since they are dependent claims, once their underlying elected species claims are allowed then these non-elected species claims can automatically be added back into the application pursuant to 37 CFR 1.142(b).

By way of the Notice mailed August 1, 2008, it concludes that the Response paper filed May 15, 2008 is not fully responsive to the prior Office Action because the Applicant has amended the claims to include limitations which have been withdrawn from consideration for reading on a non-elected species. Applicant disagrees with this conclusion and asserts that the previously withdrawn limitations incorporated into the independent claim are made part of the generic claim by such action, and thus become part of the elected species for examination. However, rather than argue this point further at this time, Applicant has re-instated withdrawn claim 7 and taken that specific subject matter out of the independent claims. Applicant does add new claim 26 which is similar to withdrawn claim 6, and agrees to consider claim 26 withdrawn also, if the Examiner is not persuaded by the first argument made just-above in this paragraph. Otherwise, Applicant asserts that the pending amended and new claims are directed to Applicant's elected invention and species as made in the paper filed March 5, 2007.

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By way of the Office Action mailed April 22, 2008, it rejects claims 1-5, 8-9, and 11-12 under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over US Patent Number 6,647,549 to McDevitt et al. in view of US Patent Number 4,820,508 to Wortzman. This rejection is respectfully **traversed** to the extent that it may apply to the presently presented claims.

Summarizing, the present invention is directed to a substrate and device for applying a lip care formulation, and in particular, in conjunction with a separate in mouth oral care use. This provides a more simplistic, easier to use, lip and oral care device because the exterior surface takes on a dual role within a single device. This is specifically discussed in the application at page 2, lines 12-15, page 4, lines 15-16 and page 30, line 22 to page 31, line 9. More generally this is discussed at page 4, line 17 to page 7, line 10, namely, page 5, lines 9-17, and page 24, line 22 to page 28, line 2. Such invention requires a combination of recited features, including *inter alia*, (i) a lip care formulation disposed on a first portion of an exterior surface of the device and to form a lip care treatment zone and (ii) a second portion of the exterior surface comprising a texturized surface to form an oral care treatment zone configured to clean the teeth and gums of a user, and (iii) the lip care treatment zone is separate from the oral care treatment zone.

In light of the presently claimed invention, the art of record clearly fails to teach or suggest such separate zones, and in fact teaches away from such a combination of features, and thus the previous rejection is deemed moot. In particular, as amended, the invention recites that the exterior surface has a dual role to function as a lip care applicator in one zone and to function to clean the teeth and gums at a separate zone. Such is contrary to the teaching in the art of record which teaches only one homogenous use for the taught devices. Accordingly, claim 1 and new independent claim 23, as well as the dependent claims, are non-obvious and patentably distinct over the art of record, and in particular over McDevitt et al. alone and in combination with Wortzman.

By way of the Office Action mailed April 22, 2008, it rejected claims 1-5 as allegedly being obvious for nonstatutory double patenting over claims 1-2 of US Patent Number 6,647,549 to McDevitt et al., and over claims 1 and 29 of US Patent Number 6,721,987 to McDevitt et al. These rejections

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are respectfully **traversed** to the extent that they may apply to the presently presented claims. For at least the same reasons just discussed above, namely, the exterior surface taking on a dual role within a single device, there can be no double patenting based on the cited McDevitt et al. patents.

All of the objections and rejections made in the office action are believed to be overcome or rendered moot based on the above amendments and remarks. Applicant respectfully submits that claims 1-5, 8-9, 11-12, and 23-30, as well as withdrawn dependent claims upon any of these, are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (920) 721-6854 to facilitate prosecution of this application.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-6854.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I, Tara Pohlkotte, hereby certify that on August 14, 2008, this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300.

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